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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,778	12/17/2001	Douglas D. Sjostrom	02-35-0385 / 00167-456001	4406
7590	06/29/2006		EXAMINER [REDACTED]	NGUYEN, VI X
JOEL R. PETROW Smith & Nephew, Inc. 1450 Brooks Road Memphis, TN 38116			ART UNIT [REDACTED]	PAPER NUMBER 3734

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/015,778	SJOSTROM, DOUGLAS D.
	Examiner Victor X. Nguyen	Art Unit 3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 18-81 is/are pending in the application.
- 4a) Of the above claim(s) 18-24, 60-63, 66-69 and 78-81 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 25-59, 64-65 and 70-77 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

**Election/Restrictions**

1. This application contains claims 18-24,60-63,66-69 and 78-81 drawn to non-elected inventions. In 4/14/2006, applicant elected to prosecute Group II, Species 1 that associated with figures 1-6. Furthermore, applicant has stated that Species 1 should include figures 7-8. The examiner agrees with the applicant that the election requirement has shifted so that Species 1 includes figures 1-8 for the purposes of examination. Therefore, non-elected claims 18-24,60-63,66-69 and 78-81 are withdrawn from further consideration.

The requirement is deemed proper and is therefore made **Final**.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-43,45-59,64-65 and 70-77 are rejected under 35 U.S.C. 102(b) as being anticipated by Banko (U.S. 3,732,858).

Banko discloses in figs. 10,12, col. 3, lines 64-67, col. 4, lines 5-10 and lines 23-31, a surgical cutting instrument having the limitations of the above listed claims, including: a cutting instrument comprises an outer member (52b) has an opening (at the tip of passage means 40b) bounded by a sharp cutting edge (the sharp cutting edge is considered at the tip of segment 78b), where a helical knife (130) coupled to the outer member for rotation relative to the outer member. The helical knife (130) would inherently has an edge to slide into tough, fibrous tissue

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to draw the tissue proximally along the helical knife towards the sharp cutting edge. Further, it is noted that fig. 10 of Banko can be clearly defined an inner member (42b) including a shaft having a helical knife (130) with a v-shaped (v-shaped is considered from the left end of helical knife 130b to the right end of segment 130b) that defined a sharp, slicing edge.

Regarding claims 26-27, wherein the edge of helical knife (130) extends distally through the opening; and where the cutting edge and the edge of helical knife configure to cut tissue.

Regarding claims 33-34 and 50-51, where the device further includes a hub (68), where the outer member (52b) defines a fluid. The cutting edge is located at a distal end of the outer member. The outer member tapers to the cutting edge (fig. 10).

Regarding claims 70-77, Banko discloses the tough, fibrous tissue can comprise cartilage, fibroid tissue or meniscal cartilage as claimed in figs. 15-17, col. 1, lines 28-31, lines 66-68 and col. 2, lines 1-2.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Banko (U.S. 3,732,858).

Banko discloses the invention substantially as claimed. Although, Banko does not disclose the inner member and the outer member is in the range of about 0.0005 to 0.002 inches.

It would have been obvious matter of design choice to modify the inner member and the outer member is in the range of about 0.0005 to 0.002 inches, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re-Aller*, 105 USPQ 233.

*Response to Amendment*

4. Applicant's arguments filed 11/14/2005 and 4/14/2006 have been considered but they are not persuasive. In response to applicant's argument that Banko reference does not disclose a helical knife has an edge configured to slice into tough, fibrous tissue and drawing the tough, fibrous tissue proximally along the helical knife towards a sharp cutting edge. As claims 25,42,59 and 64-65 are currently written, these claims can be interpreted broadly that the Banko at least disclose in figure 10, the helical knife (130) would inherently has an edge to slide into tough, fibrous tissue to draw the tissue proximally along the helical knife towards the sharp cutting edge. Further, it is noted that fig. 10 of Banko can be clearly defined an inner member (42b) including a shaft having a helical knife (130) with a v-shaped (v-shaped is considered from the left end of helical knife 130b to the right end of segment 130b) that defined a sharp, slicing edge. Regarding the intended use of the helical knife has an edge configured to slice into tough, fibrous tissue and drawing the tough, fibrous tissue proximally along the helical knife towards a sharp cutting edge, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, helical knife of Banko would have been capable of performing the use as claimed. In a claim drawn to a process of

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making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*VY BUI*  
\_\_\_\_\_  
06/26/06

VN  
6/26/2006

**VY BUI**  
**PRIMARY EXAMINER**

Victor X Nguyen  
Examiner  
Art Unit 3734

*Victor X Nguyen*